

Appl. No. 09/597,196  
Pre-Appeal Brief Request for Review

Page 1 of 6 **RECEIVED**  
**CENTRAL FAX CENTER**

**IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE**

DEC 07 2005

Appl. No. : **09/597,196**

Applicant(s) : **Zimmerman**

Filed : **6/20/2000**

TC/A.U. : **2141**

Examiner : **Baugh, April L.**

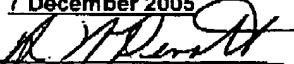
Atty. Docket : **US000127**

**CERTIFICATE OF MAILING OR TRANSMISSION**  
I certify that this correspondence is being:

[ ] deposited with the U.S. Postal Service with sufficient postage as first-class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

[X] transmitted by facsimile to the U.S. Patent and Trademark Office at **(571) 273-8300**

On: 7 December 2005

By: 

**Title: TOKEN-BASED PERSONALIZATION OF SMART APPLIANCES**

**Pre-Appeal Brief Request for Review**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the final Office action of 2 November 2005, applicant requests review of the final rejection in the above referenced application. No amendments are being filed with this request. This paper is being filed with a notice of appeal.

**This review is requested for the reason(s) stated on the attached sheet(s).**

US000127 Pre-Appeal Review 5.B02

Atty. Docket No. **US000127**

Appl. No. 09/597,196  
Pre-Appeal Brief Request for Review

Page 2 of 6

REMARKS

**Clear errors in the examiner's objection(s)/rejection(s):**

The Office action objects to claim 7 because it is dependent upon claim 9, which is not a preceding claim, as required in MPEP 608.01(n). The applicant respectfully maintains that MPEP 608.01(n) applies to original filings of applications, and not to the order of claims as might develop as an application is amended during the course of prosecution.

**The examiner's omissions of one or more essential elements needed for a prima facie rejection:**

The Office action rejects claims 5, 7, 9, 10, 12-21, and 24-25 under 35 U.S.C. 103(a) over Hunter (USPA 2001/0047426) and White et al. (USP 5,983,273, hereinafter White). The applicant respectfully traverses this rejection.

**Claims 5 and 14-20**

Claim 5, upon which 18-20 depend, claims an appliance, that includes a controller and a receiver that receives a device identifier from a communications device; the controller being programmed to transmit data corresponding to the device identifier to the relay server, and receive a profile address in response from the relay server, and to receive profile data from a profile server, based on the profile address.

Claim 14, upon which claims 15-17 depend, claims a method of controlling an appliance, that includes: receiving an address of a relay server from a remote device, transmitting a request to the relay server, receiving an address of a profile server from the relay server, based on the request, transmitting another request to the profile server, receiving a profile from the profile server, based on the other request, and controlling the appliance in dependence upon the profile.

The Office action asserts that Hunter's "routing server" corresponds to the applicant's "remote device", Hunter's "resolution server" corresponds to the applicant's "relay server", and Hunter's "content server" corresponds to the applicant's "profile server". Using this mapping, the Office action asserts that Hunter teaches "receiving a profile from the profile server, based on the second request (paragraphs 037-0042)." (Office action, page 3, paragraph 4a, last bullet.) The applicant respectfully disagrees with this characterization of Hunter.

**Appl. No. 09/597,196**  
**Pre-Appeal Brief Request for Review**

**Page 3 of 6**

Hunter does not teach receiving a profile from the content server.

In the cited paragraphs, Hunter refers to profile information only at paragraph [0040]:

"Where there are user-specific parameters such as presentation language, a user registering for a service via a linkage code could have profile information passed from the user database 214 into the service registration process. This would potentially allow the registration form to be pre-populated with the user's information, thus allowing the user to simply confirm the information, rather than having to laboriously enter it."

As clearly taught by Hunter, the user provides the profile information, and includes it with the registration information. Hunter specifically teaches that this registration process occurs first, before any requests are sent to the profile/content server, at paragraph [0030]. Hunter further specifically teaches that this registration information that may contain the profile information is transmitted from the client to a registration server; it is not received from the profile/content server, at paragraph [0028].

Further, the Office action notes that White teaches the downloading of a user's profile from a Web-TV server to a Web-TV device/client. The applicant concurs with this characterization of White, but respectfully maintains that, absent the applicant's disclosure, there is no suggestion in the prior art to combine White and Hunter.

The Office action asserts that the combination of Hunter and White is obvious "for the purpose of accessing user or device profile/configuration data from a server in order to securely provide the appropriate requested data to the client appliance according to information and preferences in its profile" (Office action, page 4, first full paragraph). The applicant respectfully maintains that this rationale is a rationale for White's invention, and is completely unrelated to Hunter's teachings. That is, the Office action's asserted purpose for a combination is completely satisfied by White's invention, and does not suggest a combination with Hunter.

Hunter addresses a system for receiving communications on a wireless telephone, PDA, or similar device in a format that is compatible with the particular device. Hunter does not teach or suggest downloading profile information to Hunter's devices, and specifically teaches that the profile information is uploaded from the devices. Further, Hunter does not teach or suggest such downloading to control an appliance.

**Appl. No. 09/597,196**  
**Pre-Appeal Brief Request for Review**

**Page 4 of 6**

White addresses a system for downloading a profile for controlling an appliance, but does not teach or suggest obtaining an address for one device, then contacting that device for another address to a third device, to obtain the profile. There is no suggestion in White to add this complexity to White's design, and there is no suggestion in White to couple White's teachings with a system such as disclosed by Hunter.

Because Hunter does not teach the elements of the applicant's invention as asserted in the Office action, and because there is no suggestion in either Hunter or White to combine their teachings, and because Hunter and White teach opposing concepts regarding the uploading or downloading of profile data, the applicant respectfully maintains that the rejection of claims 5 and 14-20 under 35 U.S.C. 103(a) under Hunter and White is unfounded.

#### **Claims 9-10, 12-13, 21, and 24-25**

To support the rejection of claim 9, upon which claims 10, 12-13, and 21-25 depend, the Office action merely asserts that claims "9 and 16 contain limitations substantially similar to claim 14 and are therefore rejected under the same basis". Based on the remarks above regarding claim 14, the applicant respectfully maintains that the rejection of claims 9-10, 12-13, 21, and 24-25 under 35 U.S.C. 103(a) over Hunter and White is unfounded.

Additionally, claim 9 claims a method of controlling the operation of an appliance that includes receiving, at the appliance, first access data from memory of a first remote device, the first access data providing network access to first configuration data; receiving at the appliance at least a portion of the first configuration data via the network access; configuring the appliance to a first configuration based on the portion of the first configuration data; receiving, at the appliance, second access data to the appliance from a memory of a second remote device, the second access data providing network access to second configuration data; receiving at the appliance at least a portion of the second configuration data via the network access; reconfiguring the appliance to a second configuration based on the portion of the second configuration data, wherein: receiving at least the portion of the first configuration data includes: receiving first relay data responsive to a network

**Appl. No. 09/597,196**  
**Pre-Appeal Brief Request for Review**

**Page 5 of 6**

server identified in the first access data, and receiving first profile data made accessible via the network access by the first relay data; and receiving at least the portion of the second configuration data includes: receiving second relay data responsive to a network server identified in the second access data, and receiving second profile data made accessible via the network access by the second relay data.

**MPEP 2142 states:**

"To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) *must teach or suggest all the claim limitations*... If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The applicant respectfully notes MPEP 2142 clearly requires a *prima facie* showing of prior art that teaches all of the claim limitations, and not merely similar limitations. As such, the applicant respectfully maintains that the rejection of claims 9-10, 12-13, 21, and 24-25 under 35 U.S.C. 103(a) is unfounded based on MPEP 2142.

### **Claims 22 and 23**

The Office action rejects claims 22 and 23 under 35 U.S.C. 103(a) over Hunter, White, and Hanko et al. (USP 6,912,578, hereinafter Hanko). The applicant respectfully traverses this rejection, based on the remarks above regarding claim 9.

To support the rejection of claims 22 and 23, the Office action relies upon Hunter and White for teaching the elements of claim 12 (Office action, paragraph 5a); claim 12 is dependent upon claim 9. As noted above, the rejection of claim 9 over Hunter and White is unfounded per MPEP 2142 for failing to provide prior art that teaches all of the applicant's claimed limitations, and thus the applicant respectfully maintains that the rejection of claims 22 and 23 are similarly unfounded.

**Appl. No. 09/597,196**  
**Pre-Appeal Brief Request for Review**

**Page 6 of 6**

Based on the remarks above, the applicant respectfully requests the allowance of all pending claims in this application.

Respectfully submitted,



Robert M. McDermott  
Reg. 41,508  
Atty for Applicant(s)

1824 Federal Farm Road  
Montross, VA 22520  
Phone: 804-493-0707  
Fax: 215-243-7525